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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,495	06/28/2001	Shinichi Yamada	057250903	5364

7590 07/01/2004
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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,495

Applicant(s)

YAMADA ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 10, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

In view of the appeal brief filed on March 10, 2004, PROSECUTION IS HEREBY REOPENED. New rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 55 recites "a C₁₆-C₆₀ fatty acid chosen from 18-methyleicosanoic acid". Claim 55 presents a range within a range, and is vague and indefinite because as claimed the limitation is reciting genus selecting from a species.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 19, 20, 27-29, 32, 33, 52-54, 56-58, 64-66, and 72-76 are rejected under 35 U.S.C. 102(a) as being anticipated by Bergmann (US 6110450).

The broadest claims in the instant case claim a composition comprising ceramides, fatty alcohol, and cationic surfactant in a cosmetically acceptable medium, and a method of making and using the same.

Bergmann discloses hair care composition comprising at least one ceramide and/or glycosphingolipid in a cosmetically acceptable medium. See abstract. Example 2 shows an aqueous formulation comprising oleoyldihydrosphingosine, cationic surfactants (components 1 and 4), and additives. The reference teaches using 0.001-1 % of phytanol, which is a liquid fatty alcohols with 0.001-1 % of ceramides. See col. 7, lines 39-45. The preparation of the example composition is also disclosed, meeting instant claims 57 and 58. Cationic surfactants are taught in col. 6, lines 27 – 34. The reference teaches the application of the composition in permanent hair waving composition. See col. 7, lines 19 – 26. The methods for treating and protecting hair in instant claims 64, 65, 74, and 75 are inherently practiced by in the disclosure.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 21-26, 34, 59, 60, 67, 68, and 77-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergmann (US 6110450) as applied to claims 19, 20, 27-29, 32, 33, 52-54, 56- 58, 64-66, and 72-76 as above, and further in view of Maubru (US 6312674 B1).

Bergmann, discussed above, fails to teach the specific ceramides of instant claims.

Maubru teaches oxidizing composition for bleaching or permanent reshaping hair, wherein the composition comprises ceramides disclosed in col. 3, line 21 – col. 16, line 13 in order to limit or prevent “deterioration in the mechanical properties of the hair”, particularly breaking of the hair and to obtain beautiful curls that withstand blow-drying and have good hold”. See col. 1, line 38 – col. 2, line 10. The reference specifically teaches bis(N-hydroxyethyl-N-cetyl)malonamide and 2-N-oleoylaminoctadecane-1,3-diol. See col. 5, lines 1 – 16. See instant claims 25-29. It is noted that oxidizing composition is used in “fixing step” in the permanent waving/straightening process. See col. 1, lines 1-29. Adding cationic polymers as a cosmetic additive is also suggested. See col. 5, lines 54 – 58; instant claim 19, 57, 64, and 74. The reference further teaches that the invention may contain other additives that are “known for their use in oxidizing compositions for bleaching or permanent reshaping of the hair”, and that the invention may be modified in the form of shampoo. See col. 5, lines

44 – 49. The claimed process of treating is necessarily practiced when the composition is used according to the teaching in the prior art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Bergmann by adding the ceramides of Maubru in the oxidizing bleaching or permanent waving compositions of Bergmann as motivated by Maubru because 1) both Bergman and Maubru teach using ceramides in oxidizing bleaching or permanently reshaping compositions; and 2) Bergmann teaches that the specific ceramides therein limits and prevents breaking of hair and damage due to blow-drying, and produces beautiful curls. The skilled artisan would have been motivated to combine the references in expectation of successfully producing oxidizing bleaching or permanent reshaping compositions with good hair protection.

2. Claims 35-51, 62, 63, 70, 71, 80, and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergmann and Maubru as applied to claims 19-29, 32-34, 52-54, 56-60, 64-68, 72-79 above, and further in view of Dubief et al. (US 6120757) ("Dubief").

The combined references fail to teach the specific cationic surfactants of instant claims.

Dubief teaches aqueous dispersion comprising quaternary ammonium surfactants, which is useful for hair cosmetic compositions. See col. 4, line 51 – col. 6, line 2; see instant claims 35-51. The reference discloses that the

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invention can be used in permanent waving or straightening products or for washing or rinsing. See col. 6, lines 50 – 58.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. As shown by the recited teachings, the instant claims define nothing more than the concomitant use of hair care ingredients. It would follow that the recited claims define prima facie obvious subject matter. Cf. In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

In this case, given the general teaching in Maubru that conventional additives for oxidizing composition for hair can be employed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have looked to the prior arts such as Dubief for specific additives such as fatty alcohol and quaternary ammonium surfactants. The motivation to combine the ingredients to successfully formulate a hair composition for topical application is found in the teachings the prior arts that these are old and well known for hair treatment purposes.

3. Claims 30, 31, 61, 69, and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maubru, Bergmann, and Dubief as applied to claims 19-29, 32-54, and 56-81 above, and further in view of Critchley et al. (US 5198210) ("Critchley").

Maubru, Bergmann, and Dubief are discussed above. While Bergmann teaches formulations comprising cetyl and stearyl alcohol, the combined references fail to teach isocetyl or isostearyl alcohol.

Critchley teaches cosmetic compositions for skin, hair and nails which contains synthetic ceramides and emollients such as isocetyl alcohol, stearyl alcohol and cetyl alcohol. See col. 1, line 11 – col. 6, line 51; col. 10, lines 44 – 61. The equivalence of these

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of the combined references by substituting the stearyl alcohol and cetyl alcohol with isocetyl alcohol, as motivated by Critchley, because 1) all references are directed to hair care compositions; 2) Critchley teaches the use of isocetyl alcohol with ceramides; and 3) Critchley teaches the equivalence of isocetyl alcohol with those fatty alcohols used in Bergmann. The skilled artisan would have combined the references in expectation of successfully producing hair care products with similar emolliency effects.

3. Claims 35-51, 55, 62, 63, 70, 71, 80, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergmann as applied to claims 19, 20, 27-29, 32, 33, 52-54, 56-58, 64, 65, and 72-76 above, and further in view of Ochiai et al. (US 5587155) ("Ochiai").

Bergmann fails to teach 18-methyleicosanoic acid and quaternary ammonium cationic surfactants.

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Ochiai teaches hair-conditioning composition comprising 18-methyleicosanoic acid. See Table 3; Example 7; col. 1, line 54 – col. 2, line 54. The reference teaches that the fatty acid prevents hair damage and adds resilience to the hair, and renders moisturizing and hair conditioning effects. See col. 7, lines 36 – col. 8, line 60 for the application of the invention, including shampoo and permanent waving compositions. Quaternary ammonium salts are taught in col. 3, line 36 – col. 5, line 51.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the Bergmann references by adding a well known hair conditioning ingredient such as 18-methyleicosanoic acid as motivated by Ochiai because of the expectation of successfully producing a hair care products with hair protection, moisturizing, and conditioning effects.

Response to Arguments

Applicant's arguments with respect to claims 19-81 have been considered but are not moot in view of the new grounds of rejections.

Conclusion

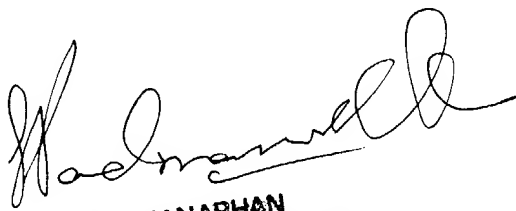
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER